3625

UNITED STATES PATENT AND TRADEMARK OFFICE

In repatent application of:

) Attorney Docket No.: F-281

Uday W. Joshi et al.

) Group Art Unit: 3625

Serial No.: 09/898,232

) Examiner: C. Nguyen

Filed: July 2, 2001

) Date: May 20, 2004

) Confirmation No.: 1871

Title:

Method and System for Customized Mail Piece Production Utilizing A

Data Center

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

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RESPONSE TO RESTRICTION

GROUP 3600

Sir:

In response to the second Restriction Requirement mailed April 22, 2004, Applicants hereby provisionally elect Group I, Claims 1-9, for continued examination, with traverse.

The Commissioner may require restriction if two or more independent and distinct inventions are claimed in one application (35 U.S.C. § 121). The independent claims in each group are directed to a method for generating a mailing including a plurality of mail pieces that includes receiving a design for a mail piece, converting the design to a viewable format, receiving an order for a plurality of the mail pieces, combining the order for the mail piece with an order for a different mail piece, and printing the mail pieces. Accordingly, the search areas for the elected subject matter will overlap the search areas for the non-elected subject matter as well and thus no undue burden would be involved in examining all pending claims together. M.P.E.P. § 803 directs as follows (emphasis added): "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the

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merits, even though it includes claims to distinct or independent inventions." This directive should be followed by the Examiner in this case.

For at least the above reasons, Applicants respectfully request that the restriction requirement be withdrawn, and that each of Claims 1-13 presently pending in this application be examined.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

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On May 20, 2004 Date of Deposit

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